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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77617272
Applicant	Glassflake International Inc.
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Date	01/13/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

***In re Application of:* GLASSFLAKE INTERNATIONAL, INC.**

SERIAL NO.: 77/617,272

FILED: NOVEMBER 19, 2008

MARK: GLASSFLAKE

INTERNATIONAL CLASSES: 1, 2, 17

TRADEMARK ATTORNEY: DREW LEASER/LAW OFFICE 112

APPEAL BRIEF

Hon. Commissioner for Trademarks
United States Patent and Trademark Office
P. O. Box 1451
Alexandria, Virginia 22313-1451

To the Trademark Trial and Appeal Board:

I. Introduction

On December 17, 2010, Applicant, Glassflake International Inc., Appellant herein, timely filed a *Notice of Appeal* from the final refusal-to-register, dated June 30, 2010, in which the Examining Attorney refused registration of Appellant's trademark in International Classes 1, 2 and 17, pursuant to §2(d) of the Trademark Act, 15 U.S.C. §1052(d). Appellant now respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's decision refusing registration and to now approve Appellant's trademark for registration on the Supplemental Register.

II. Appellant's Mark

Appellant's trademark is the word mark "GLASSFLAKE." The mark consists of "standard characters" without claim to any particular font, style, size or color. Appellant seeks registration of his mark on the Supplemental Register for the following goods recited in International Classes 1, 2 and 17:

"Chemicals used in industry, science and photography; chemicals used in agriculture, horticulture and forestry, except fungicides, insecticides and parasiticides; chemical additives for use in the manufacture of coatings, pigments, paints, polymers and vehicle tires; chemical filler preparations for use in the repair, resurfacing and patching of wood, fiberglass, metal, plastic, plaster masonry materials and concrete surfaces; chemical preservatives for use as corrosion inhibitors on metals; mineral fillers in the nature of anorthosite used in the manufacture of glass, paint and vehicle tires; glass powder as a filler for fixing with various resins," in International Class 1;

"Paints, varnishes, lacquers; pigments; preservatives against rust and against deterioration of wood in the nature of a coating; enamel paints; colorants; metals in foil and powder form for painters and decorators," in International Class 2; and,

"Additives for plastics; mica for use as fillers for plastics; expansion joint fillers; insulating paints; reinforcing materials, not of metal, for pipes, namely, pipe joint compound, pipe joint sealant, insulated pipe supports; sealing and insulating materials; plastics in extruded form for use in manufacture; plastic materials in the form of non-textile sheets, rods, blocks and of tubes, all for use in manufacture; asbestos; raw and semi-worked rubber; asbestos and rubber articles, namely, asbestos boards and rubber for use in the manufacture of vehicle tires," in International Class 17.

III. The Refusal-to-Register and Pertinent Facts

Appellant filed its trademark application on November 19, 2008, on the basis of a European Community trademark registration for the same mark owned by its related European company, pursuant to 15 U.S.C. §1126(e), §44(e) of the Trademark Act, seeking registration of the word mark "GLASSFLAKE" on the Principal Register for goods

recited in International Classes 1, 2 and 17.

On May 21, 2010, in response to the Examining Attorney's refusal-to-register Appellant's "GLASSFLAKE" trademark on the ground that the mark was "merely descriptive," pursuant to 15 U.S.C. §1052(e)(1), §2(e)(1) of the Trademark Act, Appellant amended its application from the Principal Register to now seek registration on the Supplemental Register.

On June 2, 2010, the Examining Attorney issued a further Office Action withdrawing the "merely descriptive" refusal-to-register in light of the amendment to now seek registration on the Supplemental Register and issued a new refusal-to-register Appellant's "GLASSFLAKE" trademark under §23(c) of the Trademark Act on the contention that Appellant's mark is generic for Appellant's goods and therefore incapable of registration, even on the Supplemental Register.

On June 26, 2010, Appellant replied to the Examining Attorney's genericness refusal-to-register, as well as successfully addressing outstanding issues pertaining to the indefiniteness of the recitation of goods in International Class 17.

On June 30, 2010, the Examining Attorney issued a final Office Action maintaining the §23(c) genericness refusal-to-register, thereby refusing registration of Appellant's "GLASSFLAKE" trademark on the Supplemental Register. The Examining Attorney withdrew the earlier-issued indefiniteness objection to the recitation of the goods in International Class 17, thus resolving all issues raised in the prosecution of Appellant's trademark application, except for the §23(c) genericness final refusal-to-register.

On December 17, 2010, Appellant timely filed its *Notice of Appeal* from the

Examining Attorney's refusal-to-register.

IV. Issue

The single issue for resolution on this Appeal is as follows:

Is Appellant's "GLASSFLAKE" trademark generic, and therefore incapable of distinguishing Appellant's goods, as recited in International Classes 1, 2 and 17, and consequently barred from registration on the Supplemental Register?

V. Argument

Appellant's "GLASSFLAKE" Trademark is Not Generic, or the Common Descriptive Term, for Applicant's Goods as Recited in Classes 1, 2 and 17, and Has Been Registered in the European Community

In the final Office Action issued June 30, 2010, the Examining Attorney has refused registration of Appellant's trademark, "GLASSFLAKE," pursuant to §23(c) of the Trademark Act, on the contention that Appellant's mark is generic for Appellant's goods and therefore incapable of registration, even on the Supplemental Register. More particularly, it is the Examining Attorney's stated position that Appellant's trademark "GLASSFLAKE" refers to a key characteristic, feature or ingredient of Appellant's goods, namely, that the recited goods include "glass flakes" and is therefore generic.

In reply to the Examining Attorney's "genericness" refusal-to-register, whether a particular term is generic, and therefore cannot be a trademark is a question of fact. *In re Reed Elsevier Props., Inc.*, 482 F.3d 1376, 1378, 1379-1380 (Fed. Cir. 2007). The Examining Attorney bears the burden of establishing that a proposed mark is generic, *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141,

1143 (Fed. Cir. 1987), and must demonstrate generic status by clear evidence. *See, Trademark Manual of Examining Procedure*, § 1209.01(c)(i) (4th Ed. 2005) (“The examining attorney has the burden of proving that a term is generic by clear evidence.”); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §12:12 (4th ed. 2008) (“As Judge Posner remarked [in *Ty Inc. v. Softbelly's Inc.*, 353 F.3d 528, 531, 69 USPQ2d 1213, 1215 (7th Cir. 2003)]: ‘To determine that a trademark is generic and thus pitch it into the public domain is a fateful step.’”). *See, also, Am-Pro Protective Agency, Inc. v. United States*, 281 F.3d 1234, 1239-40 (Fed. Cir. 2002) (explaining that “clear evidence” is equivalent to “clear and convincing evidence,” which is a heavier burden than preponderance of the evidence).

A generic term cannot be registered as a trademark, for generic terms by definition are incapable of indicating source. *See, In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, *supra*, 828 F.2d at 1569, 4 USPQ2d at 1143; *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-990, 228 USPQ 528, 530 (Fed. Cir. 1986) (a generic term is the common name for the genus of goods or services being sold). However, a term that is descriptive, but not generic, may acquire distinctiveness and serve as a trademark. In the generic-descriptive-suggestive-arbitrary-fanciful continuum of words and their usage as marks of trade, there is no fixed boundary separating the categories; each word must be considered according to its circumstances. *See, In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 393, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994) (“[D]escriptive terms describe a thing, while generic terms name the thing... there is only a fine line between describing and naming.” (quoting 1 *McCarthy*, §12.05[1] (3d ed. 1992))); *Zatarains, Inc.*

v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 790, 217 USPQ 988, 993 (5th Cir. 1983)

(“[t]he labels are more advisory than definitional, more like guidelines than pigeon-holes”).

Appellant’s mark is “GLASSFLAKE,” formed as a single word in the singular, as opposed to a plural usage comprising two separate words, such as “glass flakes.” Appellant’s recited goods include “chemicals” used in a wide-range of industries, “[p]aints, varnishes, lacquers; pigments,” and “[a]dditives for plastics; mica for use as fillers for plastics; expansion joint fillers. . . . reinforcing materials, not made of metal; plastic materials . . . ; asbestos; [and] raw and semi-worked rubber.” Appellant’s goods do not literally include the marketing of one or more “glass flakes” in isolation, but a wide range of unrelated products that may have a large number of very small glass flakes incorporated therein.

The “GLASSFLAKE” trademark should therefore properly be viewed as describing a feature of Appellant’s goods, rather than literally naming the goods themselves. See, *In re K-T Zoe Furniture, Inc.*, *supra*, 16 F.3d at 393, 29 USPQ2d at 1788 (“descriptive terms describe a thing, while generic terms name the thing”). Because Appellant’s goods are not literally a “glass flake” or “glass flakes,” it cannot reasonably be said that Appellant’s trademark “names” that which are Appellant’s goods. Consequently, Appellant’s mark should properly be viewed as being descriptive, not generic.

Consistent with Appellant’s view that the mere inclusion of glass flakes in a wide range of goods marketed by Appellant does not render “GLASSFLAKE” a generic term is the Examining Attorney’s initial refusal-to-register under §2(e)(1) of the Trademark

Act, 15 U.S.C. §1052(e)(1), issued as part of the first Office Action (at 2), dated February 27, 2009, refusing registration of Appellant's trademark because "the applied-for mark merely describes an ingredient of applicant's goods." It is respectfully contended that the same rationale provided by the Examining Attorney for why Appellant's trademark was "merely descriptive," namely because Appellant's "GLASSFLAKE" trademark describes "an ingredient of applicant's goods," is now being used by the Examining Attorney in support of the §23(c) refusal-to-register on the ground of genericness. More particularly, in the final Office Action, issued June 30, 2010, the Examiner stated (at 4) that:

" . . . a term does not need to be the name of the goods to be found incapable of serving as an indicator of origin. As stated in the 06/02/2010 Office action, a word or term that is the name of a key ingredient, characteristic or feature of the goods can be generic for those goods and thus, incapable of distinguishing source."

While the Federal Circuit has observed that "there is only a fine line between describing and naming" a thing, *In re K-T Zoe Furniture, Inc., supra*, 16 F.3d at 393, 29 USPQ2d at 1788, it would appear that the Examining Attorney has "erased" that "fine line" between a term that is generic and one that "merely describes" a product and is therefore capable of functioning as a trademark, by offering the identical reasoning, initially, for why Appellant's trademark is "merely descriptive" and, subsequently, why it should instead be viewed as a generic term. Because establishing the generic nature of a purported trademark requires "clear evidence," *Am-Pro Protective Agency, Inc. v. United States, supra*, 281 F.3d at 1239-40, it is contended that the Examining Attorney's inconsistent legal positions throws into doubt the alleged generic categorization of Appellant's trademark, and the resulting "doubt" should be sufficient for concluding that, in fact, Appellant's

“GLASSFLAKE” trademark is “merely descriptive” and should be permitted registration on the Supplemental Register.

Consistent with Appellant’s contention that Appellant’s “GLASSFLAKE” trademark is registrable is the European Community’s decision to issue a corresponding EC trademark registration to Appellant’s related European company – European Community Trademark Registration No. 006034987, registered June 4, 2008 – which supports the §44(e) filing basis of the instant U.S. trademark application. It is currently an “open” question yet to be resolved, however, the Federal Circuit has suggested that a “registrability determination based upon foreign registrations under Section 44 of the Lanham Act” may carry weight in resolving whether a particular mark may be registrable or is merely an unregistrable generic term. *See, In re Bayer Aktiengesellschaft*, 488 F.3d 960, 969, 82 USPQ2d 1828, 1835 n. 6 (Fed. Cir. 2007) (“We do not address here registrability determinations based on foreign registrations under Section 44 of the Lanham Act or registration proceeding under any applicable treaties or conventions.”). While the extent of foreign use might not be relevant to the issue of registrability in the United States, since the degree of foreign and domestic use of a particularly mark will almost certainly differ, it is respectfully submitted that the implicit determination by the European Community that Appellant’s “GLASSFLAKE” trademark is registrable – and therefore not a generic term – should be accorded probative weight in resolving the issue presented in this appellate proceeding.

Finally, as the Federal Circuit stated in *Merrill Lynch, supra*, any doubt in determining the registrability of a mark, including a generic mark, which was at issue in

Merrill Lynch, should be resolved in favor of an applicant “on the theory that any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect.” In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., *supra*, 828 F.2d at 1571, 4 USPQ2d at 1144, *quoting In re Gourmet Bakers, Inc.*, 173 USPQ 565 (T.T.A.B. 1972). The weight of evidence presented, Appellant contends, leaves, at a minimum, doubt, and fails to rise to the level of “clear and convincing,” to find that Appellant’s “GLASSFLAKE” trademark is generic.

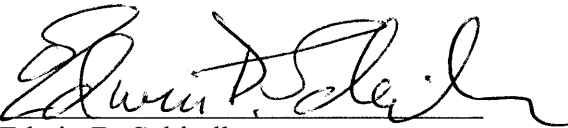
VI. Conclusion

In light of the foregoing, it is respectfully contended that the Examining Attorney’s final refusal-to-register under §23(c) of the Trademark Act, pertaining to the Examiner’s contention that Appellant’s “GLASSFLAKE” trademark is a generic term incapable of distinguishing source, should now be reversed by the Trademark Trial and Appeal Board by holding that Appellant’s mark is “merely descriptive” and may eventually acquire distinctiveness, thereby justifying registration on the Supplemental

Register at this time. Such favorable action is respectfully requested and earnestly solicited.

Respectfully submitted,

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January 13, 2011

The Commissioner for Trademarks is hereby authorized to charge the Deposit Account of Appellant's Attorney, Account No. 19-0450, for any fees which may be due in connection with the prosecution of the above-identified trademark application, but which have not otherwise been provided for.